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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

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on Feb 24, 2006

Signature Hsin-Chao Liao

Typed or printed name HSINCHAO LIAO

Application Number	Filed
09/896,727	June 29, 2001

First Named Inventor: HSINCHAO LIAO

Art Unit	Examiner
2611	CHOWDHURY, S. A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- [x] applicant/inventor.
- [ ] assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- [ ] attorney or agent of record. Registration number _____
- [ ] attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____

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Feb 24, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

- [x] *Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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Pre-Appeal Brief Request for Review

Appl. No.	:	09/896,727	Confirmation No. 8720
Applicant	:	Hsinchao Liao	
Filed	:	June 29, 2001	
TC/A.U.	:	2611	
Examiner	:	Sumaiya A. Chowdhury	
Docket No.	:	-	
Customer No.	:	-	

Overview

Applicant humbly requests the Panel's recommendation of action(s) on the prosecution of application number 9/896,727. Applicant believes the examiner made the final rejections without full consideration of applicant's prior response mailed on September 29, 2005. Applicant requests the Panel to rescind the final office action and recommend revisions to the claims under M.P.E.P Section 2173.02 and Section 707.07(j).

In aforementioned response, pages 18-20, applicant demonstrated very simply that present invention is novel and unexpected, both in physical structure and functionality, in view of the references cited by the office actions. Applicant attempted to incorporate these arguments into the amended claims. The final office action, however, rejected said claims without reference to these simple arguments. Applicant requests the panel to review these arguments. Applicant hereby formally requests assistance and constructive feedback from the panel in regards to appropriate methods for emphasizing these arguments in the claims.

Applicant understands but disagrees with the rejections of the claims in the final office action. The differences in interpretations of references will be argued in the Appeal Brief if necessary. However applicant prefers to expedite prosecution, and thus requests the panel to review this document and recommend alternative actions towards speedy allowance.

Background

In this section, applicant briefly describes and contrasts two devices in question: (1) an embodiment of the present invention, and (2) the precedent invention of Inoue's cited by the office actions. Applicant emphasizes the obvious incompatibilities.

The mobile device of the present invention receives and decodes stock prices from broadcast. However, without any user interaction, it announces, displays and saves only the information associated with the stocks listed on an attached compact flash card.

Inoue's device receives and demodulates TV signals; it requires additional software to be loaded from an attached compact flash card in order to decode stock prices. The user must interactively select the stocks to record to a storage medium.

General Arguments

It is plain that the two devices are not the same: The applicant's device includes a component that implements logic to decode and filter data (without loading additional executable software from an external device), but Inoue's does not. In fact, Inoue emphasizes (e.g. in claim 1) that executable software programs for decoding content must not remain in the device's memory.

The office action infers that Inoue's device can personalize data in the way claimed by applicant through execution of external software. The inference is unreasonably broad as any device that executes arbitrary external programs fits the description of a general computer. Conversely any general computer can be programmed to fulfill the purpose of either applicant's device or Inoue's device. Thus the applicant only claims a special device simpler than a general computer (and Inoue's device) that filters and processes broadcast data.

"Embedded computer" is a phrase that denotes logic built into the hardware. Different logic means different hardware device. Applicant specifies an embedded computer as the component of the present invention that filters and processes data. Inoue also specifies an embedded computer, but as a component that executes software programs loaded externally. Although the applicant's and Inoue's devices may be drawn with similar diagrams, it is plain that the two embedded computers contain different logic, and therefore are different devices. It is imaginable that one computer may emulate the other. However it is inappropriate to conclude that under section 103(a), that one computer can be obviously built from, or substituted for another. The research, development, financial resources, personnel, tools and processes required in replacing one computer by another -- they are not obvious at all.

Applicant emphasized these simple arguments in the response to non-final rejection mailed on September 29, 2005. On page 18, applicant emphasized that a specialized device cannot be obviously constructed from a generally programmable device. On page

19, point 2 of Claim 1, applicant again emphasized the distinct structures of the devices in question.

The final office action made no objection to, and no rejection based on these arguments. Under the reasonable assumption that examiner was in agreement with applicant, the applicant requests the panel's assistance to incorporate these arguments into the claims so that they can be allowed.

Claim Arguments

In this section applicant briefly exposes errors in the final office action in the rejection of independent claim 1.

(1) Applicant claims a device that personalizes data automatically, i.e. without user interaction. Inoue's device requires interaction, as explicitly stated in Inoue column 10, lines 58-65, column 14, lines 26-29, and column 17, lines 53-58. Although the applicant's claim does not explicitly state automatic processing, it is implied by the lack of explicit requirement of user interaction, and obvious from the specifications. Thus, as specified and claimed, Inoue's device cannot perform the function of the present invention in any obvious fashion; hence the section 103(a) rejection is invalid. However, applicant will include automatic processing in claims if requested.

(2) Applicant claims a device that personalizes data. Office action argues that Inoue's device can personalize data, however, only through the execution of external programs, as stated in Inoue column 9, line 42 to column10, line 52, and claim 1. As explained in the previous section, each device cannot be made from the other in an obvious fashion, thus invalidating the Section 103(a) rejection.

(3) Inoue neither describes nor claims personalization. The combination of Inoue's and other devices to personalize data, automatically and to the same extent as the present invention, is a questionable inference. Applicant will refute this inference in Appeal Brief if necessary.

Summary

Applicant has precise arguments and sufficient evidence to challenge the rejections of the office action. However, instead of filing an Appeal Brief, applicant prefers to incorporate disambiguating and/or distinguishing details into the claims for quick resolution.

Applicant has twice requested assistance in drafting allowable claims based on the specification and arguments stated in the original application as well as in the amendment. However, applicant received only an advice to obtain an attorney (Interview Summary mailed on 8/15/2005) – a welcome recommendation with merit, but infeasible because patent attorneys who take individual inventors as clients are rare and unaffordable. Hence applicant requests assistance from the USPTO for the third time.

Respectfully submitted,

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Certificate of Mailing: I certify that on the date below this document and referenced attachments, if any, will be deposited with the U.S. Postal Service as Certified Mail in an envelope addressed to: "Mail Stop AF, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450."

Hsinchao Liao, February 24, 2006